UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/620,683	07/15/2003	Norihiro Edwin Aoki	AOL0080	9636

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EXAMINER
CHANKONG, DOHM

ART UNIT	PAPER NUMBER
2452	

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10/20/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
	10/620,683	AOKI, NORIHIRO EDWIN
Office Action Summary	Examiner	Art Unit	
	DOHM CHANKONG	2452	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>21 July 2008</u>.
2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1,5-8,11-13,16,17,19,20 and 23-25</u> is/are pending in the application.
    4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) <u>1, 5-8, 11-13, 16, 17, 19, 20, and 23-25</u> is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a)☐ All b)☐ Some * c)☐ None of:
        1.☐ Certified copies of the priority documents have been received.
        2.☐ Certified copies of the priority documents have been received in Application No. _____.
        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)
1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1.   This action is in response to Applicant's amendment and remarks filed on 7/21/2008.

Claims 1, 12, 13, 24, and 25 are amended. Claim 16 is canceled. Claims 1, 5-8, 11-13, 16, 17,

19, 20, and 23-25 are presented for further examination.

2.   Because there is a new ground of rejection for claim 25 that was not necessitated by

Applicant's amendment, this action is a non-final rejection.

Response to Arguments

3.   With respect to the §103 rejections, Applicant's arguments with respect to claim 1, 5-8,

11, 12, 13, 17-20, and 23-25 have been considered but are not persuasive. Applicant

incorporates a limitation from dependent claims and 24 into the independent claims. With respect

to interpreting the limitation Applicant is reminded that "[c]laim scope is not limited by claim

language that suggests or makes optional but does not require steps to be performed, or by claim

language that does not limit a claim to a particular structure." MPEP §2111.04. Examples of

claim language that may raise a question as to the limiting effect of the language in a claim

include "wherein" clauses. Id. Moreover, for system or apparatus claims, "[a] claim containing

a 'recitation with respect to the manner in which a claimed apparatus is intended to be employed

does not differentiate the claimed apparatus from a prior art apparatus' if the prior art apparatus

teaches all the structural limitations of the claim." MPEP §2114 (citing Ex parte Masham, 2

USPQ2d 1647 (Bd. Pat. App. & Inter. 1987)).

       Here, Applicant has amended the apparatus (system) claims 1 and 25 and method claim

13 to now recite, *inter alia*, an element that "*is capable* of asking a series of questions to said messaging client to determine intent" (emphasis added). It is also noted that Applicant relies on "wherein" clauses to further the system and agent of claims 1 and 25. The limitation is worded so that the limitation of asking a series of questions is not actually necessary or required to be performed. Rather, the element only needs to be "capable" of performing the limitation. The limitation of "asking a series of questions" is written functionally and does not affect the claim's structure. As long as a prior art reference teaches an agent and the taught agent is "capable" of asking a series of questions, then the prior art's agent meets the claim. Applicant should amend the claims with structural limitations in the case of claims 1 and 25 to differentiate between the claims and the prior art structure. For method claim 13, Applicant should make the step required rather than optional. The step is optional because the agent only need to be "capable" of performing the step. Additionally, the use of the "wherein" clause suggests that the functionality being recited does not actually limit the scope of the claim. Applicant should amend the limitations in terms of structure. For instance, Applicant may consider introducing hardware elements that make the functionality being claimed possible rather than relying on functional language.

As set forth in the previous action, Leber discloses an automated agent [0064: chat-bot]. Leber's agent is capable of performing the new limitation because the bot is in communication with a messaging client and sends specific communications to the messaging client [abstract]. Similarly, Zircher discloses that bots may send invites to other users to join the collaboration [abstract]. Because both Leber and Zircher disclose a bot that sends and interacts with a

messaging client (sending tailored responses, sending invites) that is "capable" of asking a series

of questions to a messaging client.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4.   Claim 25 is rejected under 35 U.S.C. 101 because the claimed invention is directed to

non-statutory subject matter. Software *per se* does not fall within a statutory category of

invention under §101 because software *per se* is neither a process, a machine, manufacture, or a

composition of matter. Thus, claims directed purely to software alone are deficient under §101

for failing to recite statutory subject matter.

Here, claim 25 recites a "robot agent." Applicant's specification provides no explicit

definition for an "agent." As is well known in the art, an agent may be interpreted as either a

hardware component or a software component such as a program. Because Applicant's

specification provides little guidance as to how "agent" should be interpreted, the term is given

its broadest reasonable meaning. Under an interpretation where "agent" may be implemented as

software only by one of ordinary skill in the art, the claim fails to fall within a statutory category.

This rejection may be overcome by amending the claim to clearly recite a hardware element. As

the claim is currently written however, the "robot agent" may be interpreted as a purely software

component and therefore is rejected under §101.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

5.   Claims 1, 5-8, 11, 12, 13, 17-20, and 23-25 are rejected under 35 U.S.C §103(a) as being

anticipated by Leber et al, U.S Patent Publication No. 2003|0182391 ["Leber"] in view of

Zircher et al, U.S. Patent No. 7.139.798 ["Zircher"].

6.   Leber and Zircher were both cited in the previous Office action, filed 4.9.2007.

7.   As to claim 1, Leber discloses a system for manipulating and updating data in a backend

system, said apparatus comprising:

a messaging client for exchanging messages over a network with a messaging server

to and from other messaging clients and said backend system [Figure 1 «items 100, 110, 119,

130» | 0062-0064];

an automated agent which is coupled to between said messaging system and said backend

system which is capable of accepting requests and issuing responses, and which obtains and uses

data input from said messaging clients to determine said manipulating and updating of data

[0064-0069, 0138, 0254]; and

wherein said automated agent is capable of asking a series of questions to said messaging

client to determine intent [Leber, abstract & Zircher, column 10 «lines 2-5»];

Leber fails to disclose the automated agent initiating communications with other

messaging clients and mediating a discussion related to said input data. However, such a feature

was well known in the art at the time of Applicant's invention. Zircher is directed towards a

system for establishing a collaboration space involving messaging clients and bots or automated

agents [abstract]. Like Leber, Zircher discloses that the automated agents are coupled between

the messaging system and is capable of accepting requests and issuing responses to client queries

[column 9 «lines 28-41»].

However, Zircher's bots provide additional functionality over Leber's agents. For

example, Zircher's bots are capable of initiating communications with other messaging clients

[column 10 «lines 2-5» : "Some bots could automatically invite users to shared spaces"] and

mediating a discussion related to said input data [column 14 «lines 43-51» where : bots act as

managers for the shared space and can modify the space | column 21 «lines 27» to column 22

«line 9» where : a FAQ bot "mediates" a discussion by responding to user queries within the

collaboration space]. It would have obvious to one of ordinary skill in the art to have adapted

Leber's automated agents to include the additional functionality taught in Zircher. Providing the

additional functionality such as the ability to automatically communicate with other clients and

manage a collaboration space with multiple clients into Leber would increase the capabilities of

Leber's agents including enabling collaboration among users in a shared spaces, scheduling

meetings or calendar functions [column 19 «lines 32-46» | column 20 «lines 17-31»].

8.   As to claim 5, Leber discloses the automated agent appearing as a buddy on a buddy list

[0267].

9.   As to claim 6, Leber discloses said other messaging clients are associated with

prospective meeting attendees and said discussion related to a meeting of said attendees [0096-

105].

10.   As to claim 7, Leber discloses aid automated agent is capable of responding with

information, confirmation, availability, and a request for additional information [0096-0146].

11.   As to claim 8, Leber discloses said messaging client exchanges messages via said

network with said messaging server by any of two-way messaging, email, a paging network, and

instant messaging systems [Figure 1].

12.   As to claim 11, Leber discloses said messaging clients engage in dialogs with said

automated agents [0096-0146].

13.   As to claim 12, Leber discloses said automated agent performs any of:

        proactively sending to said messaging client messages comprising, but not limited to

alerts and reminders [0096-0111]; and

        determining resource availability [0095-0111].

14.   As to claims 13, 16, 17, 19, 20, 23 and 24, as they do not teach or further define over the limitations of claims 1, 5-8, 11, and 12, claims 13, 17, 19, 20, 23 and 24 are rejected for at least the same reasons set forth for claims 1, 5-8, 11, and 12.

15.   As to claim 25, Leber discloses a robot agent for receiving Instant Messages from a first user-client and responsively interacting between the first user-client, a calendar server system, and other user-clients to enable each of the user-clients to enter queries and updating data into, and to receive queries and data from, the calendar server system [Figure 3 «items 300, 306, 315» | Figure 5 «items, 520, 530, 522, 526» | 0030-0034], wherein said robot agent is capable of asking a series of questions to said messaging client to determine intent [abstract – bot in communication with the messaging client].

Leber does not disclose the robot agent initiating messaging communications with other and mediating a discussion related to said data input by the first user. However, as discussed with relation to the rejection of claim 1, such a feature was well known in the art at the time of Applicant's invention as taught by Zircher. See the rejection of claim 1 for rejection rationale and combination motivation.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DOHM CHANKONG whose telephone number is (571)272-3942. The examiner can normally be reached on Monday-Friday [8:30 AM to 4:30 PM].

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Bunjob Jaroenchonwanit can be reached on 571.272.3913. The fax phone number

for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would

like assistance from a USPTO Customer Service Representative or access to the automated

information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Dohm Chankong/
Examiner, Art Unit 2452